

REMARKS

Claims 1-35 are pending in the application. All of claims 1-35 are rejected in the Final Office Action mailed June 28, 2004. The issues raised in the Final Office Action are:

- Claims 1-10, 23, 24, 26-29, 34 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oren et al*;
- Claims 11-22, 32, and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oren* in view of *Ramaswami et al*;
- Claims 25, 30, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oren* in view of *Bromley et al*; and
- Applicant's arguments with respect to claims 1-35 are considered moot in view of the new ground(s) of rejection.

Rejections under 35 U.S.C. § 103(a)

Claims 1-10, 23, 24, 26-29, 34, and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oren et al.* (U.S. Patent No. 5,844,887, hereinafter *Oren*). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criteria, Applicant asserts that the Examiner's rejection of these claims does not satisfy the first and/or third criteria.

Improper Motivation

The Examiner concedes that *Oren* does not expressly teach "wherein each facility interface circuit cards is connected to one and only one said line card. See Section 2, page 2 of Final Office Action. However, the Examiner asserts that "[a]t the time of the invention, it would be obvious to a person of ordinary skill in the art to combine such an each of said

facility interface circuit cards is connected to one and only one said line card teaching in the instant claim with *Oren*.” Office Action, Paragraph 2. Furthermore, the Examiner asserts that the motivation for doing so would have been “to provide a [sic] faster processing in a packet/cell delivery network.” *Id.*

It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness. See M.P.E.P. § 2143.01. It is equally well settled that the prior art must suggest the desirability of the claimed invention. *Id.* *Oren* does not detail such desirability. Rather, the motivation supplied in the Office Action is derived from the Applicant’s disclosure. See Office Action, page 3, paragraph 2 (stating “it would have been obvious to combine the instant claim and *Oren* the invention as specified in this claim 1). The teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicants’ disclosure. See M.P.E.P. § 2143, citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Thus, the motivation to combine provided by the Examiner is improper, as the motivation must be described in a prior art reference and must detail the benefits of such a modification.

Moreover, in establishing obviousness under 35 U.S.C. § 103(a), the proposed modification to the prior art cannot render the prior art unsatisfactory for its intended purpose. See M.P.E.P. § 2143.01. *Oren* teaches that its multiple connections provide redundancy, and modifying *Oren* in the manner suggested by the Examiner would reduce such redundancy. See Fig. 17 description at Col. 19, line 56 of *Oren*.

In this case, the Examiner has impermissibly used knowledge from the Applicant’s own invention to modify a prior art reference. Also, Applicant respectfully asserts that combining gleaned knowledge from the Applicant’s disclosure with the prior art *Oren* reference constitutes impermissible hindsight. See M.P.E.P. § 2145 (citing *In re McLaughlin*, 170 U.S.C. 209, 212 (CCPA 1971)). The rejection of claims 1-10, 23, 24, 26-29, 34, and 35 under 35 U.S.C. § 103(a) as unpatentable over *Oren* is respectfully traversed for the above reasons, and Applicant requests that the Examiner withdraw the rejection of these claims.

Not All LimitationsClaim 1

The Examiner has stated that claims 1-10, 23, 24, 26-29, 34, and 35 are unpatentable over *Oren*. However, regarding claim 1, the Office Action admits that *Oren* “failed to explicitly disclose wherein each of said facility interface circuit cards is connected to one and only one said line card.” To cure this deficiency, the Examiner asserts that the disclosures of Figure 5 of *Oren* illustrate such a limitation.

Applicant respectfully asserts that, on its face, Figure 5 of *Oren* shows a switching fabric with a plurality of port interface modules 50 each connected to multiple junction modules 52. Top input bus 90 and bottom input bus 94 each connect to multiple junction modules 52. The Examiner’s attention is directed to Col. 11, lines 8-11 of *Oren*, which describe that “[s]witching fabric can also output a multicast cell, input on any physical port, to any combination of the 112 possible physical output ports supported by switching fabric 150.” This aspect of *Oren* can only be accomplished according to Fig. 5 if multiple junction module connections are present for each input port interface module so that a cell can be routed to the correct output port. Because multiple junction module connections must be present for each input port interface module, *Oren* does not teach or suggest the limitation of each of said facility interface circuit cards is connected to one and only one said line card. Therefore, *Oren* does not teach or suggest all of the limitations of claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) is improper.

Claim 5

Claim 5 has been rejected under 35 U.S.C. § 103(a). Applicant traverses the Examiner’s suggestion that *Oren* discloses the claimed limitations of Claim 5 except for the limitation that each of the input and output interface ports comprising two paired duplicate interface circuit cards. See Office Action, Paragraph 2(e). *Oren* discloses in Figure 5 a switching fabric with a plurality of port interface modules 50 each connected to multiple junction modules 52. Top input bus 90 and bottom input bus 94 each connect to multiple junction modules 52. Claim 5 contains the limitation wherein paired duplicate interface circuit cards are each connected in parallel with one and only one said line card, such that one and only one said line card is connected to each of the paired duplicate interface circuit cards.

Because *Oren* does not teach or suggest all of the limitations of claim 5, a 35 U.S.C. § 103(a) rejection of this claim is not proper. Applicant respectfully requests that the Examiner withdraw the rejection of record for claim 5 and pass this claim to allowance.

Claim 23

Applicant respectfully traverses the Examiner's assertion that the claimed subject matter of claim 23 is unpatentable over *Oren*. The Examiner admits that *Oren* does not explicitly disclose the claimed limitation of if one said duplicate data stream satisfies said criteria and the second said duplicate data stream does not satisfy said criteria, then selecting said duplicate data stream that satisfies said criteria and discarding said duplicate data stream that does not satisfy said criteria. See Office Action, Paragraph 2(k). *Oren* discloses procedures for operation in the event of a failure detected in a fabric card. The procedure to be followed in *Oren* in the event of failure is for an interface card attached to a defective card to transmit on terminals in a redundant row. See Col 20, lines 49-52 of *Oren*. The terminal switching between rows is performed by a multiplexor device programmed by the system manager or host. See Col. 20, lines 53-55 of *Oren*.

Applicant respectfully traverses the Examiner's assertion that this inherently discloses the limitation of claim 23 and implies that the duplicate data stream does not meet the predetermined selection criteria because the failure occurs. *Oren* does not discard a duplicate data stream that does not satisfy predetermined selection criteria as in the claimed subject matter. Therefore, because the *Oren* reference does not teach or suggest all limitations of claim 23, the 35 U.S.C. § 103(a) rejection of this claim is improper.

Claims 2-4, 6-22, and 24-35 depend from claims 1, 5, and 23, respectively. As such, they inherit all of the limitations of the base claims. Because the *Oren* reference does not disclose all of the limitations of claims 1, 5, and 23, the 35 U.S.C. § 103(a) rejections of record for claims 2-4, 6-22, and 24-35 were not proper. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of these claims and pass them to allowance.

Rejection under 35 U.S.C. § 103(a)

Claims 11-22, 32 and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oren* in view of *Ramaswami* et al. (U.S. Patent No. 6,597,826). As these claims depend from claims 5 and 23, they inherit all of the limitations of the base claims. Because the *Oren* reference does not teach or suggest all of the limitations of claims 5 and 23, the 35 U.S.C. § 103(a) rejections of record for claims 11-22, 32, and 33 was not proper. Accordingly, Applicant respectfully traverses the Examiner's rejection of these claims and requests that the Examiner pass them to allowance.

Rejection under 35 U.S.C. § 103(a)

Claims 25, 30, and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oren* in view of *Bromley* et al. (U.S. Patent No. 6,658,021). As these claims depend from claims 23, they inherit all of the limitations of the base claims. Because the *Oren* reference does not teach or suggest all of the limitations of claim 23, the 35 U.S.C. § 103(a) rejections of record for claims 25, 30, and 31 was not proper. Accordingly, Applicant respectfully traverses the Examiner's rejection of these claims. Applicant requests that the Examiner withdraw the rejection of record and pass these claims to allowance.

Response to Arguments

The Examiner states that the Applicant's arguments in the remarks filed on April 19, 2004 with respect to claims 1-35 are moot in view of the new ground(s) of rejection. Claims 1-7, 9, and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Oren*. Claims 1-2 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Lamberg* et al. (U.S. Patent No. 6,408,000, hereinafter *Lamberg*).

Regarding claim 1, the Examiner states in Section 5 of the Office Action that "the rejection to the claim 1 is moot in view of the new ground of rejection as described above." Applicant understands this to mean that the 35 U.S.C. § 102(b) rejections of record to claim 1 based on *Oren* and *Lamberg* have been withdrawn in view of the new 35 U.S.C. § 103(a) rejection based on the teachings of *Oren*.

Regarding claim 5, the Examiner states that “the rejection to claim 5 is moot in view of the new ground of rejection.” Applicant understands this to mean that the 35 U.S.C. § 102(b) rejection of record based on *Oren* to claim 1 has been withdrawn in view of the new 35 U.S.C. § 103(a) rejection based on the teachings of *Oren*.

As the Applicant believes that the Examiner has withdrawn the 35 U.S.C. § 102(b) rejections of record for claims 1 and 5, and because claims 2-4, 6-7, and 9-10 depend directly from these claims, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 102(b) rejection of record for claims 2-4, 6-7, and 9-10.

Claims 8, 23, 24, 26-29, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oren*. Applicant respectfully traverses the Examiner’s maintenance of the rejections of these claims. Applicant respectfully asserts that the Examiner has not demonstrated that the *Oren* reference discloses all of the limitations of claim 23, as discussed above. Claims 8, 24, 26-29, 35, and 35 all depend either directly or indirectly from base claims 5 or 23. Since claims 5 and 23 are not obvious over *Oren*, Applicant respectfully requests that the Examiner withdraw the § 103(a) rejection of record for these claims.

Regarding claim 8, Applicant respectfully traverses the Examiner’s statement that the Office Action dated 2/2/04 rejected claim 8 on the basis of *Oren* alone. The Office Action clearly cited to both *Oren* and *Ramaswami* on page 8 of the Office Action. (“The M x M configuration of *Oren et al.*, as taught by *Ramaswami*...”).

Claims 11-22, 32, and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oren* in view of *Ramaswami*. These claims depend directly or indirectly from claims 5 or 23, and accordingly inherit all of the limitations of the respective independent base claims. For the reasons discussed above, claims 5 and 23 are not obvious over *Oren* in view of *Ramaswami*. Accordingly claims 11-22, 32, and 33 are also not obvious.

Claims 25, 30, and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oren* in view of *Bromley*. These claims depend directly or indirectly from base claim 23, and accordingly inherit all of the limitations of the base claim. As *Oren* does not teach or

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suggest all of the limitations of claim 23, claims 23 should be allowable. Accordingly, claims 25, 30, and 31 should be allowable over the cited subject matter.

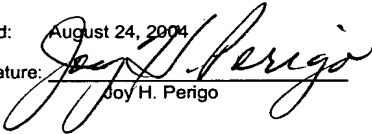
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 59182/P012US/10021641 from which the undersigned is authorized to draw.

Dated: August 24, 2004

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482734341US, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: August 24, 2004

Signature: 
Joy H. Perigo

Respectfully submitted,

By 

Michael A. Papalas

Registration No.: 40,381

FULBRIGHT & JAWORSKI L.L.P.

2200 Ross Avenue, Suite 2800

Dallas, TX 75201-2784

(214) 855-8186

(214) 855-8200 (Fax)

Attorney for Applicant